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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,072	08/28/2001	David Goodman	Poly-32	5656

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EXAMINER
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LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/941,072	<b>Applicant(s)</b> GOODMAN ET AL.	
	<b>Examiner</b> Etienne P LeRoux	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

*Claim Status:*

Claims 1-43 are pending. Claims 1-43 are rejected as detailed below.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites “determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier.” The specification does not include a clear and concise description of the manner and process of determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier such that a skilled artisan can make and use the present invention. Examiner will assume the process of determining a new label for a new floppy disk reads on “determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier.” Furthermore, close scrutiny of the specification failed to ascertain a single instance of a unique **label identifier** (emphasis added). Examiner consulted a common dictionary<sup>1</sup> for a definition of label identifier and found “Any text string used as a label, such as the name of a procedure or a variable in a

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program or the name attached to a hard disk or floppy disk.” Based on above dictionary definition, examiner assumes that no difference exists between the claimed unique volume label and the claimed unique label identifier because unique volume label and unique label identifier are used interchangeably in the present invention as a means of naming a floppy disk.

Claims 2-14 are rejected for being dependent from a rejected base claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-15, 19-27, 29-35 and 39-42 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,483,602 issued to Haneda (hereafter Haneda), as best examiner is able to ascertain.

#### Claims 1 and 20:

Haneda discloses:

a) determining whether or not the storage medium has been assigned a unique volume label and a unique label identifier [identification code is stored on the original film, on the user’s recording medium and on the laboratory’s recording medium, col 4, lines 8-15]

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<sup>1</sup> Microsoft Computer Dictionary, Fifth Edition.

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b) if the storage medium has not been assigned a unique volume label and a unique label identifier, then

(i) determining a unique label identifier for the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15],

(ii) determining a unique volume label for the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15],

(iii) writing the unique volume label onto the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15], and

(iv) providing a command to generate a label based on the unique label identifier, the label to be associated with the storage medium [identification code is stored on the original film, on the user's recording medium and on the laboratory's recording medium, col 4, lines 8-15]; and

c) updating a database based on files, if any, added to or deleted from the storage medium [col 7, lines 3-15]

Claims 2 and 21:

Haneda discloses d) synchronizing the database with a database on a device apart from the read/write machine [Fig 2, 36]

Claim 3:

Haneda discloses the read/write machine is a personal computer [Fig 2, 30] and the device is a handheld device [paragraph 46]

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Claim 4, 22 and 23:

Haneda discloses wherein the device is an untethered handheld device [paragraph 14 – wireless]

Claim 5 and 24:

Haneda discloses wherein the read/write machine is a computer with at least one of (a) a floppy disk drive, (b) a CD ROMK drive, (c) a ZIP drive, and (d) a DVD drive [Fig 1, 16]

Claim 6 and 25:

Haneda discloses wherein the label based on the unique label identifier is a bar code label [Fig 12]

Claim 7 and 26:

Haneda discloses wherein the act of determining a unique volume label is based, at least in part, on state information accessible to the read/write machine [col 15, lines 1-50]

Claim 8 and 27:

Haneda discloses wherein the state information is a count sequence [frame identification number, col 5, lines 35-45]

Claims 10 and 29:

Haneda discloses (d) accepting information read from a label associated with the storage medium without reading the storage medium, (e) converting the accepted information into a database key, (f) requesting records from a database instance using the database key (g) accepting records in response to the request and (h) rendering information about the accepted records [Fig 2, col 19, lines 7-20]

Claims 11 and 30:

Haneda discloses wherein the label associated with the storage medium is a bar code and wherein the information read from the label is accepted from a bar code scanner [Fig 2].

Claims 12 and 31:

Haneda discloses wherein the information about the accepted records rendered includes file names [Fig 14].

Claims 13 and 32:

Haneda discloses wherein the accepted information read from a label associated with the storage medium is read by a handheld device, and the information about the accepted records is rendered on the handheld device [paragraph 39]

Claim 14:

Haneda discloses wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld device [Fig 2, col 19, lines 7-20]

Claims 15 and 35:

Haneda discloses:

- (a) accepting one or more search parameters [user requests extra prints from laboratory, col 4, lines 5-15, user retrieves according to frame numbers of the film, col 3, lines 55-60, ]
- (b) generating a query based on the search parameters [user requests extra prints from laboratory, col 4, lines 5-15]
- © accepting one or more records returned in response to the query generated [order data transmitted to the laboratory system, col 4, lines 30-40]

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(d) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium [photographs are printed, col 4, lines 40-48, user is provided with printer, col 5, lines 25-30, creating a slide-show, col 9, lines 45-60]

Claim 19 and 39:

Haneda discloses wherein each of the labels include human-readable part, and wherein the information associated with each of the one or more labels accepted corresponds to the human-readable part of the labels [Figs 8 and 9].

Claim 33:

Haneda discloses a database [Fig 1, 10].

Claim 34:

Haneda discloses means for synchronizing the database with a database maintained by a separate machine which created the storage medium [Fig 1, paragraph 36]

Claim 40:

Haneda discloses wherein if the storage medium has not been assigned a unique volume label and a unique identifier then further, generating a label based on the unique label identifier and fixing the generated label to the storage medium without storing it on the storage medium [Fig 12, col 21, lines 5-20].

Claim 41:

Haneda discloses wherein if the storage medium has not been assigned a unique volume label and a unique identifier then further, generating a label based on the unique label identifier



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and fixing the generated label to the storage medium without storing it on the storage medium [Fig 12, col 21, lines 5-20].

Claim 42:

Haneda discloses wherein the information rendered is related to the label associated with the storage medium storing one or more files identified with the one or more records accepted such that a user or scanner can distinguish the storage medium including the label from other storage media [col 3, lines 43-50]

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 4,864,616 issued to Pond et al (hereafter Pond), as best examiner is able to ascertain.

Claims 9 and 28:

Haneda discloses the elements of claims 1/15 as noted above but does not disclose wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium. Pond discloses wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a

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second field having a value associated with a file stored on the storage medium [col 3, lines 35-55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include wherein the database includes records, each record including a first field having as value associated with the unique volume label, and a second field having a value associated with a file stored on the storage medium as taught by Pond for the purpose of positively identifying a file in storage such that it can be quickly and accurately retrieved.

Claims 16-18 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda in view of US Pat No 5,971,279 issued to Raistrick et al (hereafter Raistrick), as best examiner is able to ascertain.

Claim 16 and 36:

Haneda discloses the elements of claims 15/35 as noted above and furthermore, Haneda discloses (e) accepting information read from the machine-readable labels [Fig 12, col 21, lines 6-20] but does not disclose (f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans. Raistrick discloses (f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans [Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include (f) if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first

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indicator, said first indicator able to be perceived by humans as taught by Raistrick for the purpose of providing the user with positive indication that a bar code has been successfully read.

Claims 17 and 37:

The combination of Haneda and Raistrick discloses the elements of claims 15 and 16/35 and 36 and furthermore discloses g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans [Raistrick, Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include g) if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted, then generating a second indicator, said second indicator able to be perceived by humans for the purpose of assisting the visually impaired.

Claim 18 and 38:

The combination of Haneda and Raistrick discloses the elements of claims 15-17/ 35-37 as noted above and furthermore, Raistrick discloses wherein the first indicator is a first audible sound and the second indicator is a second audible sound [Fig 3].

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda.

Claim 43:

Haneda discloses the elements of claim 1 as noted above but does not disclose updating the database based on files deleted from the storage medium. Official notice is taken that updating the database based on files deleted from the storage medium is well-known and

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accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Haneda to include updating the database based on files deleted from the storage medium for the purpose of making searching simpler by eliminating from the database directory files which have been deleted.

### *Response to Arguments*

Applicant's arguments filed 10/14/2005 have been fully considered but they are not persuasive.

#### **Applicant Argues:**

Applicant states in the paragraph joining pages 15 and 16 "Independent claims 15 and 35 are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium."

#### **Examiner Responds:**

The above limitation is clearly mapped to the appropriate teachings of Haneda in supra Office Action. Nevertheless, above limitation is reconsidered as below.

#### Instance No. 1:

In column 3, line 55 through column 4, line 15, Haneda discloses that a user can display on a playback apparatus, images related to film rolls and frame identification numbers of such rolls.

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Instance No 2:

In column 4, lines 7-15, Haneda discloses that the laboratory's recording medium can search for order information and render such order information by means of printed copies of the images.

Instance No 3:

In column 9, line 25 through column 10, line 20, Haneda discloses that a user is able to search a user's database on a user's recording medium and select slides for a slide-show.

**Applicant Argues:**

Applicant states in the paragraph joining pages 17 and 18 "In summary, the Haneda patent is much different from embodiments consistent with the present invention. The examiner equates the label in Haneda with the search parameters in claims 15 and 35. However, the claimed invention determines information about a relevant label (which allows a user to read these labels electronically or visually). On the other hand the Haneda patent starts with the label as its input, rather than outputting information pertaining to the label."

**Examiner Responds:**

Examiner is not persuaded. Examiner has mapped above claim elements to pertinent sections of the cited prior art and is confident that the cited prior art discloses the gist of the present invention. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence.

*In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

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Still further, examiner maintains the following disclosure by Haneda is particularly pertinent.

Column 3, lines 13-25:

A method of managing film images according to the present invention comprises the steps of capturing an image from a film that has been developed to thereby convert the image to original digital image data representing the image, converting the original digital image data to reduced digital image data representing a reduced image, storing the reduced digital image data on a user's recording medium, storing the original digital image data on a laboratory's recording medium together with an identification code of the film, and applying the identification code to the film and to the user's recording medium on which the reduced digital image data has been stored.

### *Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022.

The examiner can normally be reached Mondays through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

1/4/2006

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', written over the printed name and date.